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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/476,662 06/07/95 KATZ

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R 6646-101NF EXAMINER	
BROWN, T	
ART UNIT	PAPER NUMBER

2601
DATE MAILED: 12/27/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☐ Responsive to communication filed on _____. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 29-49 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-28 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. The drawings are objectionable because the same reference number (92) is used for two different elements: see Figure 3, right corner "EXIT", and Figure 4, "PROCESSING UNIT". Correction is required. The text of course also will need correction of the dual use.

2. The disclosure is objected to because of the following informalities:

The introductory cross-reference to related applications is objectionable because it does not indicate the abandoned status of the ultimate ancestor application.

The brief description of the drawings (on page 4) is objectionable because it does not cite, much less describe, Figure 9 of the drawings.

Note a misspelling at page 7, line 32.

As noted above with respect to the drawings, there is an objectionable dual use of the same reference number (92) for two elements of the drawing. See page 17, line 25 and page 19, line 11.

The first sentence on page 25 is unclear, and apparently needs to be divided into two sentences.

The opening parenthesis at page 41, line 34 lacks a closing mate.

Appropriate corrections are required.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action of the predecessor applications.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description and enabling disclosure of an aspect of the claimed invention.

The last two lines of claim 40 characterize the objective of the function of the defined "designation structure" as "to isolate a subset of calling remote terminals", which is not found to be supported by the original disclosure. As far as the examiner has been able to determine, the specification refers only to "isolat[ing] a subset of callers" (emphasis added), rather than of calling terminals.

5. Claim 40 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

6. Claims 32 and 41-49 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 32, at lines 3-4, "executing said interface" (emphasis added) is unclear. All of the other references in the claims and in the main specification to "interface" are understood to represent a structural entity: see claim 35, and the preamble of claim 29, and elsewhere. Therefore, it is unclear what would be meant by "executing" a structural entity.

On the other hand, if applicant did intend the "interface" of claim 29 to define a set of operational interactions as might be concluded from the claim 32 phrasing, rather than a structural entity as had been presumed by the examiner with respect to the other claims and the text proper, then all of claims 29-35 would be considered unclear, because it is unclear what is meant by controlling a set of interactions, or even what is intended to constitute such a set, since the original text is found to intend that the "interface" is a structural entity, as shown for example at #20 in the drawings, and as described in the text.

In claim 41, line 21, "isolating a subset" ...of what? Also, in lines 19-23 of claim 41, the recitation of three apparently distinct types of "processing data" is unclear, especially with

respect to the dependent claims (such as 44 and 46) that refer to "said processing data". In claim 41, there is defined "processing data" to be provided by the "processing means" (line 19), "registered processing data" (line 20, emphasis added), and "processing data associated with said individual callers" (line 23). Perhaps applicant intended the latter "processing data" to be included in or identified with the processing data to be "provided" by the "processing means"; however, that is not made clear by the present claim construction.

In claim 43, at lines 2-3, "said certain select ones of said individual callers" lacks antecedent basis.

7. In claim 36, line 4, "telephone" (second occurrence) is objectionable for inconsistency with "telephonic" in line 2.

In claim 45, lines 3-4, "transferring certain of said individual callers to a terminal" is objectionably misdescriptive, where applicant presumably meant instead "transferring calls of certain of said individual callers to a terminal" (emphasis added). Although the examiner acknowledges that it is known in popular general usage to refer to "transfer you to another office", etc., as one of ordinary skill in the art has long known, it is actually the call that is transferred, not the caller.

8. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 36 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 38 of U.S. Patent No. 4,845,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because anyone of ordinary skill in the art would have recognized that the "digital signals provided from said communication facility" could have been the readily available DNIS, which furthermore were well known to be used for selecting "formats", as recited in the present claim 36, by comparison to the otherwise much narrower claim 38 of the patent. The examiner also believes that others of the presently sought claims may be identifiable as obvious over other claims of applicant's cited patent; however, it seems unnecessary to expend the effort and time to closely analyze and compare all of the claims sought herein to all of the claims of the patent, furthermore with the necessary consideration of all of the available teachings of the *hundreds* of references of record in the various applications related to this one, as possibly applicable in combination with the '739 patent's claims. Inasmuch as the claims of this application, to the extent understood, clearly are much broader than most of the claims of the '739 patent, it should suffice to address that fact by comparing the sought claim 36 to the patent's claim 38, as done above. Of course, if applicant submits the usual terminal disclaimer in proper form, the issue would be obviated, anyway.

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10. In the rejection below, the cited references are of record in applicant's copending application 08/073,585 mailed in May of 1995, the third action in that case, cited herein for brevity as "5/95, #3", that is, the third action in that case. Also for economy of effort, the references are not listed on the PTO-892 with this action, since they were all listed on Forms PTO-1449 in an Information Disclosure Statement ("IDS") filed November 17, 1994 in applicants' copending application 08/139,307, along with copies of the references cited therein. Applicant in this case is asked to submit for this case a copy of the Forms PTO-1449 that were submitted and considered (and copies returned to applicant) in the '307 case, so that the examiner need not re-copy the references therein for the present case.

11. Claim 36 is rejected under 35 U.S.C. § 103 as being unpatentable over the Canadian patent publication No. 1,162,336 ("Canadian" hereinafter) in view of the 1983 article "Conversing With Computers" by Adams in *Computerworld on Communications* ("Adams" hereinafter) and the Perdue et al. article (on the AT&T "CONVERSANT 1" system), when considered with or without the related 1984 articles from the *San Francisco Chronicle* or *San Francisco Business Journal* ("SF articles" hereinafter, along with specific date of particular referenced of the articles) cited in applicant's "Set I" Forms 1449 in the '307 application.

The "function unit means", "interface means" and "coupling means" structures of this claim are considered to be clearly inherent in the references, several of which unarguably do provide the *functions* of supplying information to callers in one or more "formats", do "interface" to receive "terminal formed digital signals" (DTMF) from the callers, and do "couple" the callers through an "interface" means to the "function unit means", for selective communication, all as outlined in the subject claim. The claim provides for "supplying information in various formats (lines 7-8 of the claim) to be identified by use of

automatically-provided DNIS (lines 16-20). Initially, it should be recognized that the DNIS selection feature was not disclosed in applicant's ancestor application 06/753,299 which is the basis for his earliest related disclosures, having a filing date of July 10, 1985: rather, this feature is found to have been first disclosed by applicant in his predecessor application 07/194,258 which matured into the Patent No. 4,845,739, and therefore has an effective filing date of May 16, 1988. Therefore, any reference with a filing date prior to May of 1988 is applicable for that feature. In the context of the references (Canadian and Adams) applied above, the Perdue et al. article is considered clearly pertinent and suggestive of the DNIS feature: in Perdue et al., see the paragraph bridging pages, where it is stated that "several independent applications can be implemented on a single system", and that "The script to be run on a particular call is normally determined by either the trunk the call uses or the direct inward dialing digits forwarded to our system by the central office." (emphasis added).

It is submitted that in the context of Canadian or Adams, one of ordinary skill in the art would have recognized that the "independent applications" mentioned in Perdue et al. article were applicable to *various* formats such as described by Canadian or Adams. Canadian admittedly described only a single game "format", and Adams, although clearly referring to a possible variety of formats, does not specifically suggest that those plural formats necessarily may be served by a single system that provides different formats selectively accessible by DNIS detection at the system site. However, it is believed that Perdue et al. would have suggested that in the cited passage. Even assuming *arguendo* that the average artisan was so unobservant as to not recognize that plural formats could be served to callers at a single-site system, the different formats being selected based on different called numbers, the SF articles certainly would have suggested that. The SF articles showed that single suppliers (such as

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Megaphone Co. and Dial Info) provided plural voice-response services or "formats", including games: see therein July 3, 1984 issue (ad), November 26, 1984 issue (article), and August 15, 1984 article. The references clearly would have suggested to anyone of ordinary skill in this art that DNIS would have been useful for automatic selection of formats of service at a multi-format voice-response system that enables callers to participate in selections of information via their DTMF keypads, as apparently intended to be defined in the subject claim.

As for the subject claims' allusion (in lines 8-9) to "at least one of said formats for isolating a subset of callers", it is submitted that that phrase is essentially non-limiting, because nothing in the claim requires that a selected "format" necessarily is the one that would "isolate" a subset of callers. And even if the claim were modified to specify intent that the "isolating" format be selected, it certainly was known in the art "formats" of caller-interactive sessions could involved processing of data that would could "isolate" a subset of callers: note the examiner's prior comments on that point in 5/95, #3, Section 8, especially the paragraph bridging pages 7-8 of that action. On the latter point, note that one known evidence of the "isolating" aspect was the Vynet Corp. release, "DALLAS TELEPHONE CALL-IN GAME...", etc., cited in applicant's "SET I" 1449s with an IDS in the '307 case.

tab
8.3.96

12. Assuming that applicant will subsequently submit an acceptable terminal disclaimer that will obviate any present or possible subsequent question of obviousness-type double patenting, claims 29-31, 33-35 and 37-39 are allowed.

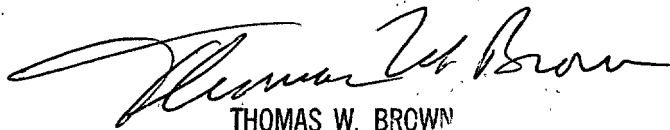
13. Claims 32 and 40 apparently would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112.

14. Claims 41-49 cannot be meaningfully compared to the prior art because of their indefiniteness as noted above. After amendment or replacement of those claims, applicants should explain how they differ from the prior art of record, and why such differing combinations are considered to be unobvious thereover.

15. With respect to claims 29-35, the product-carried participation numbers and their involvement in the qualifying of callers and in the processing of answer data to isolate a subset of callers, is not found to be suggested by the prior art.

The record structure functions relating to calling order sequence representations of callers' calls, and qualification structure for restriction of extent of access, as in claim 37, are not found to be suggested in the claimed combination.

16. Any inquiry concerning this communication or earlier ones from the examiner should be directed to Thomas W. Brown whose telephone number is (703)305-4733. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-4750.



THOMAS W. BROWN
PRIMARY EXAMINER
GROUP 2601

TWBrown
December 26, 1995